

Independent claim 1 in its preamble states that the invention, which forms the subject matter of the claim, is a portable facility for reconditioning an antifriction bearing. The preamble goes on to recite that such a bearing has "components" including a race having a raceway and rolling elements that roll along a raceway on the race. With the object reconditioned having been identified in its preamble, the claim goes on to set forth that which comprises the portable facility. According to the claim the portable facility includes an enclosure that can be moved by a transport vehicle and also equipment in the enclosure for inspecting components of the bearing and more equipment in the enclosure for repairing defects in those components. The "components" mentioned having been identified in the preamble of the claim, cannot be anything, but are instead confined.

The examiner rejected claim 1 as originally submitted, contending that it describes nothing more than that which appears in U.S. patent 4,643,476 (Montgerard), that is to say, that the portable facility set forth in claim 1 is anticipated by the Montgerard patent within the meaning of 35 USC 102. The Montgerard patent pertains to a "Mobile Band Instrument Repair Shop", and discloses a trailer-mounted enclosure containing equipment for repairing brass and woodwind musical instruments. With regard to that equipment, the examiner remarks that it "inherently can function as claimed".

A claim is anticipated only if each and every element set forth in the claim is found, either expressly or inherently described, in a single prior art reference. MPEP 2131. Moreover, there is nothing wrong with a claim that defines some

part of an invention in functional terms. MPEP 2173.05(g). Thus, the recitation of "equipment ...for inspecting components of the bearing" and "equipment... for repairing defects in components of the bearing" cannot be ignored, particularly since "components" means a race provided with a raceway and rolling elements that roll along the raceway. The Montgerard patent reveals no equipment that performs the foregoing functions. Band instruments differ markedly from antifriction bearings as disclosed in the application and defined in the claim. Moreover, equipment suitable for inspecting band instruments, if in fact the Montgerard patent shows such, could not be used to perform a meaningful inspection on the components of the antifriction bearing recited in the claims. Likewise, the equipment disclosed in the Montgerard patent for repairing band instruments would not repair components of an antifriction bearing. Thus, claim 1 defines a portable facility that differs from the portable facility for the Montgerard patent and is not anticipated by the Montgerard patent within the meaning of 35 USC 102. It is believed to be allowable.

Claims 2-7 and 19 depend from claim 1 and define the enclosure and the equipment with even more precision. They are likewise allowable.

Independent claim 8 likewise calls for a portable facility and specifies that the bearing reconditioned at the facility is a tapered roller bearing having a cup and also a cone, tapered rollers, and a cage that last of which unites the cone and rollers into a cone assembly. The claim calls for an enclosure containing stations and sets forth equipment located at the stations. For example, one of the stations, according to the claim, has equipment for opening the cage,

whereas another has equipment for closing a new cage. None of the equipment disclosed in the Montgerard patent is remotely capable of performing these functions or for that matter the other functions recited in the claim. Thus, the Montgerard patent does not anticipate claim 8 within the meaning of 35 USC 102, so claim 8 is allowable.

Claims 9-12 depend from claim 8 and further distinguish applicant's invention over the Montegerard patent. They are allowable as well.

The examiner has not rejected any of the claims under 35 USC 103 for describing a portable facility that is obvious in view of the Montgerard patent. Anticipating that the examiner may be so inclined, applicant submits herewith the declaration of Samuel R. Williams who over his long career with The Timken Company has gained a wealth of knowledge on antifriction bearings, particularly tapered roller bearings. Mr. Williams sees no correlation between antifriction bearings and musical instruments and would not expect one seeking to design a repair facility for antifriction bearings to turn to band instruments or repair facilities for such instruments for inspiration. In other words, the Mongerard patent represents no analogous art insofar as the portable facility of the claims is concerned.

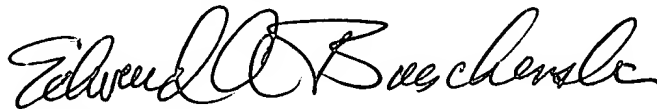
With regard to the objections to claim 1, the examiner's remarks as to the word "with" are well taken. With respect to the use of semicolons in the claim, applicant requests the examiner to reconsider the objection to them. A semicolon is appropriate between independent clauses where one seeks to obtain a stronger break than that accorded by a comma. Here applicant prefers

to use a semicolon to separate the clauses describing the individual elements that comprise the portable facility.

The Appendix to this amendment identifies the changes in claim 1.

In view of the foregoing favorable consideration and allowance of the application with 13 claims – namely, claims 1-12 and 19 – are respectfully requested.

Respectfully submitted,

A handwritten signature in cursive script, reading "Edward A. Boeschenstein".

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